IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicants: | Thomas D. Reyes | § | Art Unit: | 3696 |
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| Serial No.: | 10/634,635 | § | Confirmation No.: | 7200 |
| | | § | | |
| Filed: | 08/05/2003 | § | Examiner: | Ojo O. Oyebisi |
| | | § | | |
| For: | Method and System for | § | Atty. Dkt. No.: | 200901426-1 |
| | Effecting Payment by | § | | (HPC.0874US) |
| | Checks Through the Use of | § | | |
| | Image Replacement | § | | |
| | Documents | | | |

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Commissioner for Patents
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# REPLY BRIEF

Sir:

The following sets forth Appellant's Reply to the Examiner's Answer dated March 30, 2010.

**A.    REPLY TO EXAMINER'S ANSWER REGARDING THE § 112, ¶ 1, REJECTION**

The Appeal Brief set forth detailed reasons regarding why the subject matter of the claims is supported by the disclosure of the present application, and therefore is in compliance with § 112, ¶ 1.

The Response to Arguments section of the Examiner's Answer merely stated that the passage on page 12, line 28 – page 13, line 2, of the present application, does not include the following claim limitation:  "determining the checking account of the particular account holder based on the payment information from the purchased transaction."  The Examiner appears to be looking for a literal expression of this claim element in the specification.  That clearly is not

required, as M.P.E.P. § 2163.02 specifically states that the subject matter of a claim "need not be described literally." M.P.E.P. § 2163.02, at 2100-186. As discussed in detail in the Appeal Brief, it is clear that the specification of the present application provides written description support for the foregoing claimed subject matter.

It is therefore respectfully submitted that the claimed subject matter complies with § 112, ¶ 1.

**B.    REPLY TO EXAMINER'S ANSWER REGARDING THE § 103 REJECTION OF CLAIMS 1-16 OVER BUTTRIDGE AND ROBINSON**

As pointed out by Appellant, the Examiner erred in stating that Buttridge discloses determining the checking account of the particular account holder based on the payment information from the purchase transaction. The Response to Arguments section of the Examiner's Answer repeated the following allegation made in the Final Rejection: "inherently, Buttridge can use the received checking account information to determine the checking account of the particular account holder based on the payment information received from the purchase transaction." 03/30/2010 Office Action at 21. Using received checking account information to determine the checking account of the particular account holder is not what is recited in claim 1. Specifically, claim 1 recites receiving payment information **for** a check for a purchase transaction, where the payment information comprises a date, a payee, a dollar amount, a legal amount, and a signature. The checking account determined in claim 1 is thus based on the payment information comprising a date, payee, dollar amount, legal amount, and a signature, and not based on checking account information, as argued by the Examiner. It would be unreasonable to equate checking account information with payment information that is specifically defined by claim 1.

As conceded by the Examiner's Answer, Buttridge fails to disclose the "retrieving" and

"generating" elements of claim 1, as set forth below:

- in response to receiving the payment information:
    - determining the checking account of the particular account holder based on the payment information from the purchase transaction; and
    - **retrieving**, from a storage location storing a plurality of pre-stored image replacement document templates for each of a plurality of account holders, an image replacement document template associated with the checking account of the particular account holder used for the purchase transaction, the plurality of account holders comprising the particular account holder; and
- **generating**, using one or more computers, an image replacement document representative of the check by inserting the payment information into respective fields of the image replacement document template.

Examiner's Answer at 5-6. Instead, the Examiner cited Robinson as purportedly disclosing the

foregoing claimed subject matter.

The Appeal Brief provided detailed arguments regarding why the Examiner's allegation

that Robinson discloses the foregoing claim elements is erroneous. In the Examiner's Answer,

the Examiner again repeated the assertion that Robinson "can" disclose various features of the

claim, which is clearly based on impermissible hindsight, since Robinson provides absolutely no

hint whatsoever of the specific subject matter of claim 1 conceded to be missing from Buttridge.

*Id.* at 21. Building a template based on scanning a document and determining attributes in the

document, as taught by Robinson, has nothing to do with the claimed subject matter. Note that

claim 1 specifically recites retrieving, from a storage location storing a plurality of pre-stored

image replacement document templates for each of a plurality of **account holders**, an image

replacement document template associated with the **checking account of the particular**

**account holder used for the purchase transaction**. Moreover, claim 1 recites generating an

image replacement document representative of the **check** by **inserting the payment**

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**information into the respective fields of the image replacement document template**. Robinson merely discloses a technique for generating a template for use in production **printing**. *See, e.g.,* Robinson, 1:11-12; 2:40. Robinson does **not** disclose retrieving an image replacement document template **from among a plurality of pre-stored image replacement document templates** for each of a plurality of **account holders**.

Moreover, the template that is built in Robinson is clearly **not** associated with a **checking account of a particular account holder** used for a purchase transaction. Nor does Robinson provide any hint of a storage location storing a plurality of pre-stored image replacement document templates for each of a **plurality of account holders**. Also, Robinson would **not** have led a person of ordinary skill in the art to generate an image replacement document representative of **the check** by inserting the **payment information into respective fields of the image replacement document template**.

The primary reference, Buttridge, also fails to provide any teaching or hint of the foregoing claimed subject matter, as conceded by the Examiner. Therefore, even if Buttridge and Robinson could be hypothetically combined, the hypothetical combination of the references would not have led to the claimed subject matter.

For the reason set forth above and reasons provided in the Appeal Brief, the obviousness rejection of the foregoing claims is clearly erroneous.

**C.     REPLY TO EXAMINER'S ANSWER REGARDING THE § 103 REJECTION OF CLAIMS 17, 19-22, 24-28 OVER BUTTRIDGE AND ROBINSON**

As discussed in the Appeal Brief, the hypothetical combination of Buttridge and Robinson clearly provides no teaching or hint of electronically transmitting the snippet (of payment information received for the check on an output device) to a remote location for

generation of an image replacement document representative of the check based on the snippet. As conceded by the Examiner, Buttridge does not disclose electronic transmission of a snippet of payment information to a remote location for **generation of an image replacement document representative of the check based on the snippet**. The secondary reference, Robinson, also provides no hint of the foregoing claimed subject matter. In Robinson, an entire document is scanned from which a template is produced—there is absolutely nothing in Robinson to even remotely hint at generation of an image replacement document representative of the **check** that is based on a snippet of **payment information**.

The Examiner in the Examiner's Answer again resorted to speculation that the Robinson replacement image document generator "can generate an image replacement document representative of a check." Examiner's Answer at 24. This allegation is clearly based on impermissible hindsight. Moreover, Robinson merely relates to creating a template based on a scanned document. A person of ordinary skill in the art would clearly not have been led by Robinson to electronically transmit a snippet of payment information to a remote location for generation of an image replacement document **representative of the check** based on the snippet **of payment information**.

In view of the foregoing, it is clear that the obviousness rejection of the foregoing claims is erroneous.

## D.    CONCLUSION

In view of the foregoing, and in view of the arguments presented in the Appeal Brief,

reversal of the final rejections is respectfully requested.

Respectfully submitted,


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